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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,959	09/17/1999	KARL ERIK STAHL	927.1003	9455
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER	
			DUONG, DUC T	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/397,959

Applicant(s)

STAHL, KARL ERIK

Examiner

Duc T. Duong

Art Unit

2419

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-31 is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding to claims 25 and 26, there does not appear to be a written description of the claimed limitation "the circuit switched telecommunication network comprises a wireless telecommunication network" in the application as filed. On page 1 lines 18-20, as cited by applicant, of the specification discloses cellular telephony is a variant of PSTN. However, such disclosure appears in the background of the invention and as such is considered prior art. Furthermore, the entire disclosure is directed to wired line PSTN and there is no where else in the description of the invention disclosing support for such limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 14-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al (US Patent 7,280,530 B2).

Regarding to claims 14 and 17, Chang discloses a system 2 for telecommunication utilizing both a circuit switched telecommunication network 16 and a packet based telecommunication network 18 (fig. 1 col. 10 lines 30-51), comprising multiple gateway telecommunication devices 4-8 (fig. 1) each having a first port (connection from PBX 34 to CO1) to connect said device to a circuit switched telecommunication network (fig. 2); a second port (connection from router 32 to IP network 18) to connect said device to a packet based telecommunication network (fig. 2); means 58 for initiating and receiving (fig. 3 col. 13 lines 54-63) calls for a user

located in a home or office location where said device is also located (col. 7 lines 18-54); means 73 for said user to interface with said device without using a telecommunication network (fig. 3 col. 15 lines 1-13); means 50 in said device for executing requests from said user to initiate calls to parties on the circuit switched network or the packet based telecommunication network (fig. 3 col. 13 lines 54-63); and a single channel gateway means 58 (fig. 3 col. 13 lines 54-63) in said device 126 for establishing a path between said first port 167 and said second port 162 inside said device in response to a request from a server 26 on the packet based telecommunication network that is separate from a calling device 38 that a caller at a remote location is using, and the server acting on behalf of a caller 38 at a remote location (fig. 6-7 col. 29 lines 18-36), whereby the gateway telecommunication device can serve as part of a distributed gateway system between said packet based telecommunication network and said circuit switched telecommunication network for said caller (fig. 3A col. 11 lines 62-66) and whereby the device increases the capacity of said distributed gateway system (col. 7 lines 33-48).

Regarding to claim 15, Chang discloses a third port 73 to connect a conventional telephone apparatus 74 via said device to said first port (fig. 3 col. 15 lines 1-13).

Regarding to claim 16, Chang discloses a mechanism to automatically connect said third port to directly to said first port in the event of a power failure (col. 5 lines 46-49).

Regarding to claim 18, Chang discloses gateway location servers P1-6' connected to said packet based telecommunication network, said gateway location servers being adapted to receive a request from a first gateway telecommunication device connected to said packet based telecommunication network for telecommunication with a specified telephone apparatus on said circuit switched telecommunication network, and further being programmed to select a second of said gateway telecommunication devices to serve as a gateway between said networks for said requested connection, and to forward said request to said second gateway telecommunication device via said packet based telecommunication network (fig. 3A col. 12 lines 3-38).

Regarding to claims 19 and 20, hang discloses the packet based telecommunication network is the Internet (col. 10 lines 50-51).

Regarding to claims 21, 23, and 24, Chang discloses each of said gateway telecommunication devices includes means for registering with said gateway location servers the availability of said device to act as a gateway between said packet based network and said circuit switched network (col. 17 lines 44-62).

Regarding to claim 22, Chang discloses each of said registered gateway telecommunication devices includes means for automatically notifying said gateway location servers when its PSTN connection is Off Hook so it temporarily is not available to serve as a gateway between the packet based network and the circuit switched network (col. 47 line 66-col. 48 line 2) .

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Voit (US Patent 6,075,783).

Regarding to claims 25 and 26, Chang discloses all the limitations with respect to claims 14 and 17, except for the circuit switched telecommunication network comprises a wireless telecommunication network and the first port is arranged to communicate with the wireless telecommunication network. However, Voit discloses an Internet phone to PSTN cellular system comprising gateway server 14 with a port that's arrange to communicate with a cellular network 9 (fig. 2 col. 8 lines 45-49). Thus, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to arrange for such device for cellular network communication as taught by Voit into Chang's system to provide a methodology for facilitating telephone use of the Internet to complete calls from a landline device to a cellular device.

Allowable Subject Matter

8. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 27-31 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or make obvious the steps or means for “**a gateway location server connected to said packet based telecommunication network having information of the location of said gateway telecommunication devices, said gateway location server being adapted to receive a request from a caller anywhere on said packet based telecommunication network for telecommunication with a specified telephone apparatus on said circuit switched telecommunication network, and further being programmed to select one of said gateway telecommunication devices to serve as a gateway between said networks for said requested connection, and to forward said request to said one gateway telecommunication device via said packet based telecommunication network**”, when such gateway location server is considered within the specific structure of the device recited in claim 27.

Response to Arguments

10. Applicant's arguments filed March 16, 2009 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., receives **signaling** from a server that is separate from a calling device and handles a request to connect to a third party caller) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regarding applicant's argument on pages 8-9, Chang assumes that signaling and voice data shared the same communication path. In response, even if that was the case Chang still read on the claimed limitation "a request from a server on the packet based telecommunication network that is separate from a calling device that a caller at a remote location is using". In fig. 6-7 col. 29 lines 18-36, Chang discloses a request from a server 26 on the packet telecommunication network 18 is separate from a calling device 38. There is nothing recited in the claimed limitation of receives signaling data that is separate from voice data as argue by applicant. Thus, based on the reasons set forth here the rejections are maintained.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is (571)272-3122. The examiner can normally be reached on M-F (8:00 AM-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. T. D./
Examiner, Art Unit 2419

/Wing F. Chan/
Supervisory Patent Examiner, Art Unit 2419
4/14/09